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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,071	11/05/2003	Yoshikazu Watanabe	826.1901	6314
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER	
			JOO, JOSHUA	
			ART UNIT	PAPER NUMBER
			2154	
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			08/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/701,071

Applicant(s)

WATANABE ET AL.

Examiner

JOSHUA JOO

Art Unit

2154

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8,9 and 15 is/are rejected.
- 7) ☒ Claim(s) 2,4,7 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/21/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

1. This Office action is in response to communication dated 5/21/2008.

Claims 1-10 and 15 are presented for examination.

Response to Arguments

2. Applicant's arguments with respect to claims 1-10, 15 have been considered but are moot in view of the new ground(s) of rejection.

Rejections of claims under 35 U.S.C. 101 are withdrawn in view of Applicant's amendments.

Allowable Subject Matter

3. Claims 2, 4, 7, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- i) Regarding claim 15, the limitation of "delete protection status" has insufficient antecedent basis in the specification.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted 05/21/2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

6. Claims 9-10, 15 are objected to because of the following informalities:
- i) Claim 15 is presented without claim 14. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).
 - ii) Regarding claim 15, the phrase "when email storage is full" should be changed to "when the email storage is full". Furthermore, in the phrase, "designate the release the delete protection status" should be changed to "designate the release of the delete protection status" or a similar correction should be made.
 - iii) Regarding claims 9-10, "The storage medium" should be changed to "The computer-readable storage medium" to clearly refer to "A computer-readable storage medium".

Correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 3, 6, 8, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated Yanagida, US Patent #6,064,877 (Yanagida hereinafter).

9. As per claims 1 and 8, Yanagida teaches the invention as claimed including an electronic mail receiving method and computer readable storage medium for use in a communications terminal having an electronic mail reception function, comprising:

making to a user a notification that protection must be released if a state where a new electronic mail cannot be captured unless the protection of an existing electronic mail is released is determined, when the new electronic mail is received, or an inquiry is made to a mail server (col. 4, line 47-54. Attempt to store message as protected. If maximum protection number is exceeded, prompt user to cancel protection of a protected message.).

10. As per claim 6, Yanagida teaches the invention as claimed including a communications terminal, comprising:

a display unit;

a determining unit determining a state where a new electronic mail cannot be captured unless protection of an existing electronic mail is released, when the new electronic mail is received, or an inquiry is made to a mail server (col. 4, line 40-49. Attempt to store message as protected. Determine if maximum protection number is exceeded.); and

a guidance unit displaying a message that the protection must be released, if said determining unit determines the state where the new electronic mail cannot be captured unless the protection of an existing electronic mail is released (col. 4, line 47-54. Prompt user to cancel protection of a protected message.).

11 As per claims 3 and 9, Yanagida teaches the electronic mail receiving method according to claim 1, further comprising displaying a message requesting the user release the protection by transferring display contents to a protection release operation screen after making the notification to the user (col. 4, lines 58-67. Display candidate message(s) for protection release.).

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagida, in view of Goldberg, US Patent #5,444,438 (Goldberg hereinafter).

14. As per claim 5, Yanagida teaches the electronic mail receiving method according to claim 1, wherein the state where a new electronic mail cannot be captured unless the protection of an existing electronic mail is released. However, Yanagida does not specifically teach that the state is a state where a received electronic mail box is full and all of existing electronic mails are set to be protected.

15. Goldberg teaches of solving a state where a received electronic mail box is full and all of existing electronic mails are set to be protected (col. 1, lines 26-37).

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to allow for a state where a received electronic mail box is full and all of existing electronic mails are set to be protected, which would allow greater number of messages to be protected while still allowing messages to be pending for delivery.

17. As per claim 15, Yanagida teaches substantially the invention as claimed including a method comprising:

determining whether previously stored email messages in an email storage have a delete protection status when a new email message arrives (col. 4, line 47-54. Attempt to store message as protected. Determine if maximum protection number is exceeded.);

sending a user of the email storage a message indicating that the delete protection status needs to be released responsive to the determining (col. 4, line 47-54. Prompt user to cancel protection of a protected message.); and

allowing the user to designate the release the delete protection status of an email message (col. 4, lines 58-67. Display candidate message(s) for protection release.).

18. Yanagida does not specifically teach of determining whether all previously stored email messages in an email storage have a delete protection status when email storage is full.

19. Goldberg teaches of solving a state wherein all of previously stored electronic mails are set to be protected when an electronic mail box is full (col. 1, lines 26-37).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to allow for a state where a received electronic mail box is full and all of existing electronic mails are set to be protected, which would allow greater number of messages to be protected while still allowing messages to be pending for delivery.

Conclusion

21. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- i) Tada, US Patent #6,192,219 teaches of deleting protected messages when memory capacity is full with protected messages.
- ii) DeLuca et al. US Patent #5,473,320 teaches of a system for displaying messages based on time range, wherein protected messages may take up all available memory space.

22. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. J./

Examiner, Art Unit 2154

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2154